SUMMARY OF CLAIMS

Claims 1, 4-23, 25, and 27-30 are pending in this application. Claims 2-3, 24, and 26 are cancelled. Reconsideration is respectfully requested in view of the following remarks.

REMARKS

I. Interview Summary:

Applicants wish to thank the Examiner for courtesies extended during an interview held on April 27, 2005 with Applicants' representatives Vern Norviel and Maya Skubatch. During the interview, Applicants and the Examiner discussed the claimed invention and references of record in this case.

II. Claim Objections:

The Examiner objected to claims 13 and 29 in regards to informalities in the claims. Applicant has amended claim 13 to remove the reference to Figure 14, and amended claim 29 to properly depend from claim 28, in order to correct the informalities. Applicant has also amended claim 29 to correct a typographical error. Based on this amendment, Applicant respectfully requests withdrawal of this objection.

III. Claim Rejections Under 35 U.S.C. 103(a):

The Examiner rejected claims 1, 4-23, 25, and 27-30 under 35 U.S.C. 103(a) as being unpatentable over Voyvodic in view of Kaufman/Arakawa et al. According to the Examiner:

> "[i]t would have been obvious at the time the invention was made to a person of ordinary skill in the art to use the computer to communicate information directly to the patient via a visual display located in the gantry room in the invention of Voyvodic et al. as taught by Kaufman et al. to provide continuous feedback regarding the image data so as to allow the patient to make quicker adjustments, thereby effectively reducing scan time and improving resolution." [Office Action, at p.3]

Applicants respectfully traverse the above rejection as the Examiner failed to satisfy the burden of proof required to establish a *prima facie* case of obviousness. According to MPEP 2143, in order,

> "[t]o establish a *prima facie* case of obviousness three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one or ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claimed limitations."

"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01. Moreover, a

> "statement that modifications of the prior art to meet the claimed invention would have been "'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. See MPEP 2143.01, *citing Ex part Levengood,* 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Thus, "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." MPEP 2142. Such facts must establish that the claimed invention "as a whole" would have been obvious at the time the invention was made to person of ordinary skill in the art. MPEP 2142.

In the present case, the Examiner failed to show any evidence that would teach or suggest all of the claimed limitations or to modify the references or combine reference teachings.

In particular, Voyvodic discloses "near real-time analysis [which] allows physiological and behavioral data collected during a paradigm to be combined with the MR time series and provides extended data filtering and statistical processing within a few minutes after the end of the scan." (Voyvodic, Abstract). However, nowhere doe Voyvodic suggest or motivate the limitation of claim 1 of "employing a computer to communicate information based on the one or more determinations

to the subject in less than 10 seconds from when the activity is measured." (See Claim 1, emphasis added)

Furthermore, Kaufman discloses that "[i]f the monitor is also within the viewing field of the patient, it permits patient feedback directly." (Kaufman at Column 3, lines 3-5). However, Kaufman does not disclose or suggest the limitation of claim 1 of "measuring activity of one or more internal voxels of a brain of a subject, wherein the measuring activity is performed by an apparatus comprising an fMRI." (See Claim 1, emphasis added)

Neither Kaufman nor Voyvodic reference each other, nor is there any suggestion or motivation by Voyvodic or Kaufman to combine their teachings. Furthermore, the Examiner has failed to summit any other evidence that would demonstrate any motivation or suggestion to combine the teachings of Kaufman and Voyvodic. Thus, the Examiner has failed to satisfy the burden of proof required under 35 U.S.C. 103.

For the foregoing reasons, Applicants respectfully request that the above rejection be withdrawn.

CONCLUSION

In light of the remarks and amendments set forth above, Applicant believes that the claims are in condition for allowance. Applicant respectfully solicits the Examiner to expedite the prosecution of this patent application to issuance. Should the Examiner have any questions, the Examiner is encouraged to telephone the undersigned.

The Commissioner is authorized to charge any fees that may be required in connection with this submission, including petition fees and extension of time fees, and to credit any overpayments to Deposit Account No. 23-2415 (Attorney Docket No. 27969-702).

Respectfully submitted,

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